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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,749	08/25/2006	Vishu Dutt Dosaj	DC10015 PCT 1	2866

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EXAMINER

JOHNSON, KEVIN M

ART UNIT	PAPER NUMBER
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1793

NOTIFICATION DATE	DELIVERY MODE
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11/26/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

Office Action Summary	Application No.		Applicant(s)	
	10/590,749		DOSAJ ET AL.	
	Examiner		Art Unit	
	KEVIN M. JOHNSON		1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,7,8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7,8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/25/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status

1. Claims 1, 2, 5, 7, 8 and 10 are pending and presented for examination. Claims 1 and 10 have been amended. Claims 3, 4, 6, 9 and 11-17 are cancelled.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 8/25/2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 2, 5, 7, 8 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The process step of predicting the properties of the slag produced during the refining of the silicon metalloid based on equilibrium calculations is not enabled. The disclosure does not contain an adequate description of how the slag properties are predicted. While the disclosure states that the method of predicting the slag properties is known in the art, no evidence has been provided that one skilled in the art at the time

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of the invention would be able to predict the properties of the slag produced during the refining of the silicon based on the information provided in the disclosure of the invention without undue experimentation.

5. Attention is directed to *In re Wands*, 8 USPQ 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApl) at 547 the court recited eight factors:

1) The nature of the invention:

The instant invention is related to a process of selecting/producing silicon for use in the direct process synthesis of organohalosilanes by predicting the properties of the slag that will be produced while refining the silicon metalloid.

2) The relative skill in the art:

The relative skill in the art is high.

3) The state of the prior art:

No evidence is found in the prior art for a method of predicting the properties of slag that is formed when silicon is refined based on the impurities present in the silicon metalloid prior to refinement.

4) The predictability of the art:

The art is not highly predictable, as different lots of chemical grade silicon react differently in the direct process. Efforts have been made in the past to predict the behavior of the lots based on the contaminants present in the silicon, but these efforts,

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while affording a degree of control, have not been entirely successful as admitted in the disclosure.

5) The breadth of the claims:

The applicant's assertion that the slag properties may be predicted from the elemental impurity levels and process conditions is not commensurate with the scope of the enablement provided in the disclosure.

6) The amount of guidance presented:

No guidance is provided in the disclosure as to how the slag properties are actually predicted. The statement that the prediction of the properties is reached through the use of equilibrium equations and data is not sufficient to allow one skilled in the art to accurately predict the slag properties. The specific equations and data used to formulate the prediction are not disclosed.

7) The presence or absence of working examples:

The examples provided in the specification provide predicted slag property values, but fail to disclose the manner in which the predicted values are ascertained. With no disclosure of the actual prediction process it would not be possible for one skilled in the art to reproduce the predicted values.

8) Quantization of undue experimentation:

The lack of sufficient teaching and guidance in the disclosure as to the way in which the slag properties are predicted would prevent one skilled in the art from practicing the process of the present invention without conducting undue experimentation.

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6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 10 recites the limitation "for use in the direct process" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, 5, 7 and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The process described in the instant claims is drawn to the abstract idea of predicting slag properties and is not tied to a machine, does not require a physical transformation, and does not produce a useful, concrete or tangible result. The claims are drawn merely to the selection of a material, but do not actually provide for the use of the material. That the material is selected "for use in the direct process of making organohalosilanes" only speaks to the intended use of the material, and does not provide an actual process step using the material in such a manner as to effect a transformation of the material or produce a useful, concrete or tangible result.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN M. JOHNSON whose telephone number is (571)270-3584. The examiner can normally be reached on Monday-Friday 7:30 AM to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.A. LORENZO/
Supervisory Patent Examiner, Art Unit 1793

/Kevin M Johnson/
Examiner, Art Unit 1793